

REMARKS

The Applicant respectfully requests reconsideration and Allowance of Claims 1-7, 10-15, and 17-20 in view of the amendments presented above and the following arguments.

35 U.S.C. §103 REJECTIONS

Claims 1, 2, 4-7, 10-15, 17-19 were rejected under 35 U.S.C. §103(a) as obvious over Morgan et al. in view of U.S. Publication No. 20020184118A1 to Gronemeyer et al. ("Gronemeyer").

Claim 3 was rejected under 35 U.S.C. §103(a) as obvious over Morgan et al. (US Publication Number 20020144187A1) in view of U.S. Patent 6,628,417 B1 to Naito et al.

Claim 20 was rejected under 35 U.S.C. §103(a) as obvious over Morgan et al. in view of WO 0068783 to Miller.

STATUS OF THE CLAIMS

Claims 1-7, 10-15, and 17-20 remain pending in this case.

Independent Claims 1 and 11 have been amended to add the limitations that the inspector comprises examination data, said examination data comprised of configuration data and diagnostic data of past solutions to error problems for said computer based system, for the computer-based system and wherein the examination data is displayed by the computer-based system for user approval prior to connecting with the network addressable device. These amendments represent clarifications and do add further limitations to the respective claims.

CLAIMS 1-7, 10-15, and 17-20 ARE NOT OBVIOUS IN VIEW OF THE CITED ART

The Examiner rejected Claims 1, 2, 4-7, 10-15, and 17-19 under 35 U.S.C. §103(a) as obvious over Morgan in view of Gronemeyer. Further the Examiner rejected claim 3 as obvious over Morgan in view of Naito et al. And claim 20 as obvious over Morgan in view of Miller. Applicant respectfully traverses these rejections on the ground that Morgan, neither alone nor in combination with any of the other references, does not teach or suggest Applicant's invention as now claimed and, further, there is no suggestion in the references to modify the Morgan device in the manner now claimed.

THE MORGAN ET AL. PUBLICATION

The Morgan patent application publication discloses only a consumer network diagnostic agent whereby a user simply launches a diagnostics tool which then performs

diagnostic functions and provides the results without further user interaction. (Page 1, paragraph 0009). The tool automates diagnostic testing and may be employed as part of a self-healing system (Page 2, paragraphs 0009 and 0010). Thereafter, the user may report the results to a technical support person. (Page 5, paragraph 0048).

The Examiner on page 9 , paragraph 19, of the Final Office Action points to Morgan page 4, paragraph 0038 as describing "sending a file to a support person concerning a problem with a computer." Actually, that paragraph describes sending the attribute or attributes associated with the computer 4 to technical support personnel to "determine relative health of a computer 4, or to provide a historical snapshot of the system performance and configuration." Morgan goes on in that same paragraph to explain that "the archival of such attribute files 32 provides technical support personnel with a history of the configuration of the computer 4 at one or more points in time, which may provide insight to the cause of a current problem."

Nothing in Morgan teaches or suggests presenting the user of a computer with examination data, where the examination data is comprised of a combination of both configuration data and diagnostic data, as previously disclosed and now claimed by Applicant. Further, according to Applicant's invention, the examination data is presented to the user for approval prior to submission to technical support personnel. All that can be fairly said about Morgan is what Morgan says: "... because the tool automates the diagnostic testing, the possibility of erroneous information being provided to technical support personnel is minimized..." (Page 2, paragraph 0010)

THE GRONEMEYER PUBLICATION

The Gronemeyer patent application publication discloses a system for facilitating e-commerce transactions (Abstract). In operation, a user first opens a web browser. (Page 1, paragraph 0013). The web browser is then directed to contact a web site of a provider of goods and/or services. (Page 1, paragraph 0014). Then the web site sends the web browser a sentinel which inspects the user's "computing device" and determines needed goods and services. (Pages 1 and 2, paragraph 0015). This inspection of the user's computing device is done automatically and action is taken automatically. (Page 1, paragraph 0002).

The Examiner notes that Gronemeyer discloses on page 2, paragraph 0020 that "A first web page may be displayed of client identified configuration data and allow for entering (e.g. by a user) of additional relevant facts of context surrounding the problem." Applicant notes that the sentence immediately preceding the one quoted says: " Multiple web pages can also be configured so as to step a client through a diagnosis (e.g. trouble

shooting) session, where progressing through each web page causes client configuration data relevant to a particular diagnostic step to be sent".

Nowhere does Gronemeyer teach or suggest the creation of examination data from a combination of both configuration data and diagnostic data of past solutions to error problems and the review of such examination data by a user prior to a solution being suggested much less implemented on the user's computer.

INDEPENDENT CLAIMS 1 AND 11

In contrast to Morgan in combination with Gronemeyer, Applicant's independent Claim 1 (as well as independent Claim 11) is directed, in pertinent part, to an enduser diagnostic system including an inspector linked with a system registry and a network addressable device wherein the inspector computes examination data, the examination data comprised of configuration data and diagnostic data of past solutions to error problems for said computer based system, for the computer-based system and wherein the examination data is displayed by the computer-based system for user approval prior to connecting with the network addressable device.

Applicant's inspector 40 obtains configuration data from the system registry 26. Configuration data as used in the application refers to information required for configuring software and hardware components that define the user's computer system 20, preferably in real time. (Page 6, Lines 27-32). Inspector 40 includes a repository 45 of diagnostic data, such as past solutions to error problems. From the configuration data and the diagnostic data, the inspector 40 computes examination data, data deemed useful for assisting in the resolution of a computer-based system error. (Page 7, Lines 18-28). Once generated, the examination data is displayed to the enduser prior to any examination data being sent to an external network addressable device 33. (Page 7, Lines 29-32 and page 8, Lines 1-5). That is, in Applicant's invention as claimed, the network addressable device 33 external to the user's system receives only the examination data approved by the enduser. (Page 8, Lines 6-9). Thereafter, the external support resource 34 sends the enduser the solution to the error. (Page 8, Lines 11-13).

No such system is disclosed or suggested whatsoever by Morgan and Gronemeyer either alone or in combination. Morgan discloses a device that operates without any user intervention or input to diagnose and solve a problem automatically and internally. Only after the solution has been effected is it suggested that a user may contact external technicians to report the results.

Gronemeyer, on the other hand, discloses a system whereby first an external system is connected to a user's computer and then the user's computer undergoes diagnoses without any user intervention or additional input. Combining Morgan's internal automatic system with Gronemeyer's external automatic system seems destined to failure. In any event, even if the combination were successful it still would not result in Applicant's invention wherein examination data is first collected internally, then approved by the enduser, and only then transmitted externally for the purpose of obtaining an error solution that is then received internally by the enduser to solve the system error.

Further, Applicant respectfully submits that in order to combine prior art references or modify a prior art reference under 37 U.S.C. 103, there must be some teaching or suggestion in the prior art to make the combination or modification. In this case, the Examiner does not point to any teaching or suggestion in the prior art to add the approval of examination data required by Applicant's claims to the Morgan system, but merely asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gronemeyer with Morgan because "Combining Morgan with Gronemeyer will allow reasoning for adding additional information to a file or webpage in the case of Gronemeyer, so that a technical support person can have all the information needed to help correct the problem". (Page 9, paragraph 19). Again, it seems that providing a user the opportunity to review the internal solution already derived by Morgan's automatic internal system is superfluous to Morgan's device. It is still not clear, in any event, to Applicant what the Examiner is suggesting is the motivation here.

Most importantly, adding the review and approval of examination data as the Examiner suggests would necessarily change the principle of operation of Morgan's system. That is, Morgan is an already functioning technique for using an internal automatic diagnostic tool and adding the opportunity to review the solution prior to connecting with an external system, as the Examiner seems to suggest adding, is completely superfluous to the Morgan device.

Further, Applicant respectfully submits that if the proposed modification of the prior art would change the principle of operation of the prior art device, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2nd 810, 123 U.S.P.Q. 349 (CCPA 1959) (see MPEP § 2143.01 at page 2100-82, second column). In the present case, it is unclear to the Applicant what the Examiner proposes to accomplish by the addition to Morgan of the review and approval process prior to connecting to an external system or how it would cooperate with the existing system. It is clear, however, that if any such system is to be functioned then the principle by which Morgan's

system operates must be changed. Thus, in accordance with *In re Ratti*, it could not have been obvious to make the Examiner's proposed modifications.

Further, neither Morgan nor Gronemeyer disclose the Applicant's "examination data", a combination of configuration data and diagnostic data consisting of past solutions to error problems, as now specifically claimed. As a result for this reason alone, Applicant's invention as now claimed is allowable over the cited art.

The Applicant, therefore, respectfully submits that independent Claim 1, as well as independent Claim 11, which requires limitations similar to those in Claim 1, is not anticipated by, nor obvious over, Morgan either alone or in combination with Gronemeyer or any of the other references and both are entitled to allowance along with dependent claims 2-7, and 10, and 12-15 and 17-20 respectively.

CONCLUSION

In light of the above, Applicant respectfully requests reconsideration and allowance of Claims 1-7, 10-15, and 17-20. If the Examiner should feel that any issue remains as to the allowability of these claims, or that a conference might expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney.

Applicant intends this to be a complete response. No fee is believed due; however if a fee is due, please charge deposit account number indicated on the transmittal letter.

Respectfully submitted,

J. Nevin Shaffer, Jr., P.A.

Date: 3/26/04

By: J. Nevin Shaffer, Jr.

J. Nevin Shaffer, Jr., Reg. No. 29,858
913 Gulf Breeze Parkway, Suite 43
Gulf Breeze, FL 32561
850-934-4124

ATTORNEYS FOR APPLICANT

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: 3/26/04

Reg. No. 29,858, J. Nevin Shaffer, Jr.

J. Nevin Shaffer, Jr.